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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,948	12/06/2001	Reinhard Berger	GS 0466 A US	5713

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EXAMINER

PEZZLO, BENJAMIN A

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,948

Applicant(s)

BERGER ET AL.

Examiner

Benjamin A Pezzlo

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13 and 15-21 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of the electric motor including a rotatable drive shaft that has a longitudinal axis that is substantially parallel to the longitudinal axis of the toothed rack as claimed in claim 15 and the limitation of a gear drive system operatively connected between the electric motor and the gear as claimed in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Examiner notes that the rotatable drive shaft is not shown in the figures.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide proper antecedent basis for the term “gear drive system” as claimed in line 2 of claim 17. Examiner has interpreted the gear drive system to be the drive shaft which is connected between the electric motor and the gear.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9, 11-13, and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5954178 to Fischer et al.

Re: claims 1, 11, and 16. Fischer et al. show in figure 13 a clutch actuator 1000 for actuating an automatic clutch as disclosed in col. 29 lines 29-33 or an automatic transmission, the actuator comprising: a housing 1004 that includes an axially extending first receptacle shown in the area of the lead line of number 1012, a toothed rack (or notched bar) 1010,1013 slidably received within the first receptacle for linear movement along a rack longitudinal axis as disclosed in col. 29 lines 14-16, a second receptacle shown in the area of element 1005 adjacent to the first receptacle and within which second receptacle a gear 1005 (spur gear as disclosed in col. 28 line 39) is rotatably carried, wherein a portion of the second receptacle intersects a portion of the first receptacle to define a space that is common to both the first receptacle and the second receptacle as shown in the area above and to the right of the lead line of number 1007, wherein the gear 1005 is in meshing engagement with the toothed rack via element 1006,1009 (gear 1005 is in meshing engagement with element 1006,1009 which is in meshing engagement with toothed rack 1010) for linearly moving the toothed rack within the first receptacle, and an electric motor 1001 drivingly connected with the gear 1005, wherein the electric motor and the

gear are provided as a pre-assembled unit that is removably connected with the housing as disclosed in col. 28 lines 60-61 lines and in col. 28 lines 37-39, respectively.

Re claim 2, see Fig. 13.

Re: claim 3. Fischer et al. show in figure 13 the limitation wherein the actuator includes an energy accumulator 1012 positioned between and in contact with the toothed rack and the housing, and wherein the toothed rack is movable in a first direction of movement that is opposite to a force imposed on the toothed rack by the energy accumulator, and is movable in a second direction by the force of the energy accumulator.

Re: claims 4-6. Fischer et al. show in figure 13 the limitation wherein the energy accumulator 1012 contacts the toothed rack at a first protrusion shown in the area of the lead line of number 1013 extending outwardly from the toothed rack.

Re: claims 7-9. Fischer et al. show in figure 13 the limitation wherein the energy accumulator contacts the housing at an inwardly extending second protrusion shown in the area below the lead line number 1012a within the housing.

Re: claims 12 and 13. Fischer et al. show in figure 13 the limitation wherein the toothed rack is supported in bearings (indirectly by bearing 1007 via element 1006 and directly by bearing 1011) carried adjacent end areas of the first receptacle.

Re: claim 15. Fischer et al. show in figure 13 the limitation wherein the electric motor includes a rotatable drive shaft 1002 that has a longitudinal axis that is substantially parallel to the longitudinal axis of the toothed rack.

Re: claim 17. Fischer et al. show in figure 13 the limitation wherein the actuator includes a gear drive system 1002 operatively connected between the electric motor and the gear for transmitting rotational movement between the motor and the gear.

Allowable Subject Matter

5. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claim 14 is allowed.

Response to Arguments

7. Applicant's arguments filed 31 March 2004 have been fully considered but they are not persuasive.

Specifically, see col. 10 lines 50-62, whereat Fischer et al. discloses that nut and screw or a toothed rack may be used.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 3683

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A Pezzlo whose telephone number is (703) 306-4617. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin A Pezzlo
5/16/04
BAP
May 16, 2004

Benjamin A Pezzlo
Examiner
Art Unit 3683